

Remarks

Applicants respectfully request reconsideration of the present application in light of the foregoing amendments and following remarks.

Claims 1-13, 21, and 22 remain pending in the present application. Claims 1, 7, 13, 21, and 22 are independent.

Claim 7 is amended to address some minor typographical issues.

Claims 1-13, 21, and 22 are rejected. These rejections are respectfully traversed.

Double Patenting Rejections under 35 U.S.C. § 101

The Office Action ("Action") provisionally rejects claims 1-13, 21, and 22 under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-22 of co-pending U.S. Patent Application No. 11/058,491 ("the '491 application"). Applicants respectfully traverse these rejections.

The MPEP states the following at 804(II)(A) (with *emphasis added*):

A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). ***Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist.*** For example, the invention defined by a claim reciting a compound having a "halogen" substituent is not identical to or substantively the same as a claim reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine." On the other hand, claims may be differently worded and still define the same invention. Thus, a claim reciting a widget having a length of "36 inches" defines the same invention as a claim reciting the same widget having a length of "3 feet."

Thus, in order for statutory double patenting to exist, identical subject matter must be defined by the claims of the present application and the claims of the '491 application. Applicants submit that, for at least the reasons presented below, this is not the case.

Claims 1-6

Independent claim 1 of the present application recites the following (with *emphasis added*):

A method of connecting a first V.34 enabled fax machine to a second V.34 enabled fax machine over a network utilizing at least one gateway that operates in

accordance with the T.38 un-enhanced protocol, said fax machines having an initial handshaking process during which an AnsAm signal consisting of a 2100 Hz tone with a 15Hz envelope is generated, said method including:

- placing a call by said first fax machine to said second fax machine over a voice grade connection,
- generating an AnsAm signal by said second fax machine in response to said call,
- modifying the AnsAm signal generated during the initial handshaking by removing the 15 Hz envelope, *whereby the first fax machine does not generate a CM tone*, and said second fax machine falls back to G3 mode, and
- said first and second fax machine communicate using the G3 protocol.

In contrast, none of the independent claims in the '491 application define subject matter that is identical to that defined in independent claim 1 of the present application because, for example, none of the independent claims in the '491 application define a first fax machine that *does not generate a CM tone*. In fact, the only independent method claims in the '491 application (claims 1, 7, and 13) each define a first fax machine that *generates a CM tone or CM signal*. For example, independent claim 1 of the '491 application recites the following (with *emphasis added*):

A method of connecting a first V.34 enabled fax machine to a second V.34 enabled fax machine over a network utilizing at least one gateway that operates in accordance with the T.38 un-enhanced protocol, a method including the following steps during an initial handshaking process between said machines:

- placing a call by said first fax machine to said second fax machine over a voice grade connection,
- generating an AnsAm signal by said second fax machine in response to said call,
- transmitting said AnsAm signal to said first fax machine,
- said first fax machine generating a CM tone*,
- suppressing said CM tone so that it does not reach said second fax machine, and
- said first and second fax machine falling back to the G3 speed and communicating using the G3 protocol.

Applicants submit that claim 1 of the present application defines a first fax machine that *does not generate a CM tone*, whereas claim 1 of the '491 application defines a first fax machine that *generates a CM tone*. Applying the test for double patenting under 35 U.S.C. § 101 as presented above, Applicants submit that there is an embodiment (e.g., a first fax machine that does not generate a CM tone) that falls within the scope of one claim (claim 1 of the present application) but not the other (e.g., claim 1 of the '491 application). As such, identical subject matter is not defined by both claims and, therefore, statutory double patenting does not exist with respect to independent claim 1 of the present application for at least these reasons.

Accordingly, the 35 U.S.C. § 101 rejections of independent claim 1 and its dependent claims 2-6 are improper and should be withdrawn.

Claims 7-12

Independent claim 7 of the present application recites the following (with *emphasis added*):

A method of connecting a first V.34 enabled fax machine to a second V.34 enabled fax machine over a network that has one or more gateways that operate in accordance with the T.38 un-enhanced protocol, said fax machines having an initial handshaking process during which a CM signal is generated which includes a bit indicating that the calling fax machine is V.34 enabled, said method including:

- placing a call to said second fax machine by said first fax machine over a voice grade connection,
- generating an AnsAm signal by said second fax machine in response to said call,
- generating a CM signal by said first fax machine, said CM signal having a bit set to indicate that said first fax machine is V.34 enabled,
- modifying said CM signal in said gateway to disable said bit indicating that the calling fax machine is V.34 enabled,***
- said second fax machine falls back to G3 mode, and
- said first and second fax machine communicate using the G3 protocol.

In contrast, none of the independent claims in the '491 application define subject matter that is identical to that defined in independent claim 7 of the present application because, for example, none of the independent claims in the '491 application define modifying a CM signal in a gateway to disable a bit indicating that the calling fax machine is V.34 enabled. For example, independent claim 7 of the '491 application recites the following:

A method of connecting a first V.34 enabled fax machine to a second V.34 enabled fax machine over a network that has one or more gateways that operate in accordance with the T.38 un-enhanced protocol, said fax machines having an initial handshaking process during which a CM signal is generated said method including:

- placing a call to said second fax machine by said first fax machine over a voice grade connection,
- generating an AnsAm signal by said second fax machine in response to said call,
- generating a CM signal by said first fax machine,
- suppressing said CM signal so that it does not reach said second fax machine,
- said second fax machine falling back to G3 mode, and
- said first and second fax machine communicate using the G3 protocol.

Applicants submit that claim 7 of the present application defines ***modifying a CM signal*** in a gateway to disable a bit indicating that the calling fax machine is V.34 enabled, whereas

none of the independent claims in the '491 application define an identical feature. Applying the test for double patenting under 35 U.S.C. § 101 as presented above, Applicants submit that there is an embodiment (e.g., modifying a CM signal in a gateway to disable a bit indicating that the calling fax machine is V.34 enabled) that falls within the scope of one claim (claim 7 of the present application) but not the other (e.g., claim 7 of the '491 application). As such, identical subject matter is not defined by both claims and, therefore, statutory double patenting does not exist with respect to independent claim 7 of the present application for at least these reasons.

Accordingly, the 35 U.S.C. § 101 rejections of independent claim 7 and its dependent claims 8-12 are improper and should be withdrawn.

Claim 13

Independent claim 13 of the present application recites the following (with *emphasis added*):

A method of connecting a first V.34 enabled fax machine to a second V.34 enabled fax machine over a network that includes a first gateway connecting said first fax machine to said network and a second gateway connecting said second fax machine to said network, said gateways operating in accordance with the T.38 un-enhanced protocol, said fax machines having an initial handshaking process during which an AnsAm signal consisting of a 2100 Hz tone with a 15Hz envelope is generated, said method including:
placing a call to said second fax machine by said first fax machine over a voice grade connection,
generating an AnsAm signal by said second fax machine in response to said call, modifying said AnsAm signal generated during the initial handshaking in one of said gateway gateways by removing the 15 Hz envelope,
whereby the first fax machine does not generate a CM tone, said second fax machine falls back to G3 mode, and
said first and second fax machine communicate using the G3 protocol.

In contrast, none of the independent claims in the '491 application define subject matter that is identical to that defined in independent claim 13 of the present application because, for example, none of the independent claims in the '491 application define a first fax machine that *does not generate a CM tone*. In fact, the only independent method claims in the '491 application (claims 1, 7, and 13) each define a first fax machine that *generates a CM tone or CM signal*. For example, independent claim 13 of the '491 application recites the following (with *emphasis added*):

A method of connecting a first V.34 enabled fax machine to a second V.34 enabled fax machine over a network that includes a first gateway connecting said first fax machine to said network and a second gateway connecting said second fax machine to said network, said gateways operating in accordance with the T.38 un-enhanced protocol, said fax machines having an initial handshaking process during which an AnsAm signal is generated by said second fax machine and **a CM signal is generated by said first fax machine**, said method including:

suppressing said CM signal so that said second fax machine does not receive said CM signal,

said second fax machine falls back to G3 mode, and

said first and second fax machine communicate using the G3 protocol.

Applicants submit that claim 13 of the present application defines a first fax machine that **does not generate a CM tone**, whereas claim 13 of the '491 application defines a first fax machine that **generates a CM signal**. Applying the test for double patenting under 35 U.S.C. § 101 as presented above, Applicants submit that there is an embodiment (e.g., a first fax machine that does not generate a CM tone) that falls within the scope of one claim (claim 13 of the present application) but not the other (e.g., claim 13 of the '491 application). As such, identical subject matter is not defined by both claims and, therefore, statutory double patenting does not exist with respect to independent claim 13 of the present application for at least these reasons.

Accordingly, the 35 U.S.C. § 101 rejection of independent claim 13 is improper and should be withdrawn.

Claim 21

Independent claim 21 of the present application recites the following:

In a system for connecting a calling Super Group 3 fax machine and a called Super Group 3 fax machine over an IP network that includes gateways that operate in accordance with the T.38 un-enhanced protocol, said fax machines initially connecting over a voice grade line using the V.8 protocol, whereby the called fax machine generates an AnsAm signal, a method including the steps of:

modifying said AnsAm signal whereby the called fax machine does not respond to the AnsAm signal with a CM tone,

timing out by said called fax machine since it does not receive a CM signal,
said called fax machine falling back to G3 mode as a result of said time out, and
said calling and called fax machines proceeding to communicate in G3 mode.

Applicants submit that none of the independent claims in the '491 application define subject matter that is identical to that defined in independent claim 21 of the present application.

As such, statutory double patenting does not exist with respect to independent claim 21 of the present application for at least these reasons.

Accordingly, the 35 U.S.C. § 101 rejection of independent claim 21 is improper and should be withdrawn.

Claim 22

Independent claim 22 of the present application recites the following:

A method of connecting a first V.34 enabled fax machine to a second V.34 enabled fax machine over a network by at least one gateway that operates in accordance with the T.38 un-enhanced protocol, said fax machines having an initial handshaking process during which an AnsAm signal consisting of a 2100 Hz tone with a 15Hz envelope is generated, said method including:

- placing a call by said first fax machine to said second fax machine over a voice grade connection,
- generating an AnsAm signal by said second fax machine in response to said call,
- modifying the AnsAm signal generated during the initial handshaking by removing the 15 Hz envelope, whereby the first fax machine does not generate a CM tone, and said second fax machine falls back to G3 mode, and
- said first and second fax machine communicate using the G3 protocol.

Applicants submit that none of the independent claims in the '491 application define subject matter that is identical to that defined in independent claim 22 of the present application. As such, statutory double patenting does not exist with respect to independent claim 22 of the present application for at least these reasons.

Accordingly, the 35 U.S.C. § 101 rejection of independent claim 22 is improper and should be withdrawn.

Conclusion

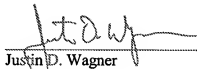
Applicants submit that the present application is in condition for allowance and such action is respectfully requested.

The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Customer No. 20575

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

A handwritten signature in dark ink, appearing to read "Justin D. Wagner", is written over a horizontal dotted line.

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